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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,391	03/01/2002	Thomas E. Creamer	BOC9-2001-0012 (247)	1315

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EXAMINER	
ELAHEE, MD S	

ART UNIT	PAPER NUMBER
2645	

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/086,391	CREAMER ET AL.	
	Examiner	Art Unit	
	Md S Elahee	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,5-16 and 19-23* is/are pending in the application.

4a) Of the above claim(s) *2,4,17,18,24 and 25* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,5-16 and 19-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Examiner has received an after final amendment from Mr. Gregory A. Nelson filed on 10/12/2004. Examiner does not agree with the arguments in the remarks of the amendment filed on 12/12/2003 that the evidence submitted overcomes the effective date of the Baals et al. reference. The reasons are shown below.

Response to Amendment

2. The affidavit filed on March 1, 2002 under 37 CFR 1.131 has been considered but is ineffective to change the invention date of the current application.

3. The evidence submitted is insufficient to establish a conception of the invention prior to February 9, 2001. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

The complete claimed invention was not conceived prior to the date of the February 9, 2001, because the attached Invention Disclosure No. BOC8-2001-0004 does not support all the claimed limitations recited in amended claims 1, 3, 5-16 and 19-23. For example, the limitation "providing a Web-enabled interface through which said participant can associate distinctive ring tones with calling parties" is not disclosed in the document.

Further, No evidences were provided to support the statement that applicants exercised due diligence from 02/09/2001 to the filing date of the current application.

4. The affidavit has a typographical error in paragraph 5, lines 3-4. Specifically, the words 'signale' and 'form' are incorrectly typed.

Response to Arguments

5. Applicant's arguments mailed on 10/12/04 have been fully considered but are moot in view of the new ground(s) of rejection which is deemed appropriate to address all of the needs at this time.

Claim Objections

6. Claims 14, and 21 are objected to because of the following informalities: Claim 14 recites the phrase "said participants" on page 5, line 12 of the claim. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

Claim 21 recites "said call characteristics" on line 1. There is insufficient antecedent basis for this limitation in the claim. Because, its parent claim 20 recites "call characteristics" twice (i.e., lines 5 and 6 of claim 20 respectively). Appropriate correction is required.

Claim 21 recites the phrase "the group consisting of" on page 6, line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1, 5-11, 13, 14, 16, 19, 20, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epler et al. (U.S. Patent No. 6,026,156) and in view of Fan (U.S. Patent No. 6,636,506).

Regarding claim 1, Epler teaches providing an interface 58 through which the user (i.e., participant) can associate distinctive tones (i.e., ring tones) with callers (i.e., calling parties) (fig.1; col.3, lines 45-47, col.5, lines 44-48, col.6, lines 7-21, col.11, lines 33-53). (Note: since the user is editing VIP code screening list or caller number screening list and distinctive tones are based on the caller's CPID, the user is inherently associating distinctive tones to respective calling parties with VIP code)

Epler further teaches receiving from a caller (i.e., calling party), over a telephony connection, call information comprising a specified telephone number of the user in the existing telephone call and a VIP code (i.e., password) (col.5, lines 60-67, col.6, lines 1-21, col.11, lines 33-53).

Epler further teaches identifying the caller using the call information (col.11, lines 33-53).

Epler further teaches causing a distinctive call waiting tone to be sent to the subscriber wherein the distinctive call waiting tone (col.5, lines 64-66) is associated with the caller, and wherein the distinctive call waiting tone was associated with caller via the interface (col.3, lines 45-47, col.6, lines 7-21, col.11, lines 33-53).

However, Epler does not specifically teach a web-enabled interface through which the participant can associate distinctive ring tones with calling parties. Fan teaches an internet telephone station [i.e., web-enabled interface] through which the participant can associate distinctive ring tones with calling parties (fig.1, 3; col.7, line 64- col.8, line 20). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Epler to have a web-enabled interface through which the participant can associate distinctive ring tones with calling parties as taught by Fan. The motivation for the modification is to have doing so in order to provide a distinctive ringing signal through an internet telephone.

Regarding claim 5, Epler teaches receiving CPID or VIP code to the Enhanced Call Waiting System, and verifying the call waiting CPID or VIP code when the call is received by the Enhanced Call Waiting System (col.13, lines 65-67, col.14, lines 1-20, 61-67, col.15, lines 1-4; 'CPID or VIP code' reads on the claim 'subscriptions' and 'Enhanced Call Waiting System' reads on the claim 'call waiting service provider').

Regarding claim 6, Epler teaches providing a list to the caller of available VIP code, receiving from the caller a selection of a VIP code, and sending a distinctive call waiting tone to the user according to the selection (col.5, lines 60-67, col.6, lines 1-21, col.11, lines 33-53; 'VIP code' reads on the claim 'call waiting messages' and 'user' reads on the claim 'participant').

Regarding claim 7 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Epler teaches an Enhanced Call Waiting System configured to receive a call from a caller (col.5, lines 60-67, col.6, lines 1-21; 'Enhanced Call Waiting System' reads on the claim 'call waiting service provider', 'caller' reads on the claim 'calling party' and 'user' reads on the claim 'participant').

Epler further teaches a distinctive call waiting tone generator configured to generate distinctive call waiting tones based upon the caller (col.5, lines 60-67, col.6, lines 1-21).

Epler further teaches a switch for transferring the received call to the user if the user elects to accept the received call (col.5, lines 60-67, col.6, lines 1-21, 28-67; 'user' reads on the claim 'participant').

Regarding claim 8, Epler teaches that the call information comprises VIP code, and further comprising the step of verifying the CPID (col.13, lines 65-67, col.14, lines 1-20; 'VIP code' reads on the claim 'password information').

Regarding claim 9, Epler teaches providing a list of available VIP code, receiving from the caller a selection of a VIP code, and a programmed call processing system for receiving from the caller a selection of a message, and for assigning a call waiting tone according to the selection (fig.1, fig.3; col.5, lines 60-67, col.6, lines 1-21, col.8, lines 15-18, col.11, lines 33-53; 'list' reads on the claim 'table', 'VIP code' reads on the claim 'call waiting messages' and 'programmed call processing system' reads on the claim 'data processing system').

Regarding claim 10, Epler teaches receiving from the caller call information, and sending a distinctive call waiting tone to the user based upon the call information (col.5, lines 60-67, col.6, lines 1-21, 28-67; 'caller' reads on the claim 'calling party' and 'user' reads on the claim 'participant').

Regarding claim 11, Epler teaches that the call information identifies the call as the category in which caller's calls fall with respect to the user and the system sends a distinctive call waiting tone to indicate to the user that the call is as the category in which caller's calls fall

(col.14, lines 61-67, col.15, lines 1-4; 'the category in which caller's calls fall' reads on the claim 'out-of-area code' and 'user' reads on the claim 'participant').

Regarding claim 13, Epler teaches that the system comprises a database comprising CPID or VIP code, and a programmed call processing system for comparing the telephone number received from the caller to the CPID or VIP code in the database (fig.1, fig.3; col.8, lines 15-18, col.13, lines 65-67, col.14, lines 1-20, 61-67, col.15, lines 1-4; 'CPID or VIP code' reads on the claim 'subscription information' and 'programmed call processing system' reads on the claim 'data processing system').

Regarding claim 14 is rejected for the same reasons as discussed above with respect to claim 7. Furthermore, Epler teaches fixed data storage for storing a list of call characteristics, wherein the call characteristics comprising a VIP code (i.e., at least one of a user name and password) (col.5, lines 60-67, col.6, lines 1-21, col.11, lines 33-53; 'Enhanced Call Waiting System' reads on the claim 'call waiting service provider', 'caller' reads on the claim 'calling party' and 'user' reads on the claim 'participant').

Epler further teaches that a computer for obtaining VIP code for received calls, wherein the call analyzer identifies a caller based upon the call characteristics (col.11, lines 33-53, col.13, lines 65-67, col.14, lines 1-20; 'computer' reads on the claim 'call analyzer' and 'VIP code' reads on the claim 'characteristics').

Epler further teaches a call waiting tone generator for producing distinctive call waiting tones according to the caller (col.5, lines 60-67, col.6, lines 1-21, col.13, lines 65-67, col.14, lines 1-20).

Epler further teaches a switch for sending the distinctive call waiting tones to the users (col.5, lines 60-67, col.6, lines 1-21, 28-67; 'switch' reads on the claim 'tone transmitter' and 'users' reads on the claim 'participants').

Regarding claims 16 and 23, Epler teaches selecting the call characteristics from a list of VIP code (col.13, lines 65-67, col.14, lines 1-20; 'list of VIP code' reads on the claim 'menu of available call characteristics').

Regarding claim 19, Epler teaches VIP code verification structure (col.13, lines 65-67, col.14, lines 1-20; 'VIP code' reads on the claim 'password').

Regarding claim 20 is rejected for the same reasons as discussed above with respect to claims 1 and 14. Furthermore, Epler teaches comparing the call characteristics for the inbound call to the list of call characteristics to identify a caller placing the inbound call (col.13, lines 65-67, col.14, lines 1-20).

Regarding claim 22, Epler teaches editing list of VIP code (col.11, lines 34-53; 'editing' reads on the claim 'creating' and 'VIP code' reads on the claim 'call characteristics').

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Epler et al. (U.S. Patent No. 6,026,156) and in view of Fan (U.S. Patent No. 6,636,506) and further in view of Mizikovsky (U.S. Patent No. 5,559,860).

Regarding claim 3, Epler in view of Fan fails to teach "said call information identifies said call as out-of-area code with respect to said participant". Mizikovsky teaches that the calling party identification data (i.e., call information) identifies the call as out-of-area code with respect to the participant (col.12, lines 61-67). Thus, it would have been obvious to one of ordinary skill

in the art at the time the invention was made to modify Epler in view of Fan to have the call information identifying the call as out-of-area code with respect to the participant as taught by Mizikovsky. The motivation for the modification is to have doing so in order to provide a distinctive ringing signal representative of a long distance caller.

10. Claims 12, 15 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epler et al. (U.S. Patent No. 6,026,156) and in view of Fan (U.S. Patent No. 6,636,506) and further in view of Kuechler et al. (U.S. Patent No. 6,108,630) and further in view of Neil (U.S. Patent No. 5,930,501).

Regarding claims 12, 15 and 21, Epler in view of Fan fails to teach "said call information comprises at least one selected from the group consisting of out-of-area code, time of day at point of origin, geographical location, and time zone information". Kuechler teaches that the call information comprises at least one selected form the group consisting of out-of-area code, time of day at point of origin (fig.4; col.6, lines 13-17). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Epler in view of Fan to have the call information comprising at least one selected form the group consisting of out-of-area code, time of day at point of origin as taught by Kuechler. The motivation for the modification is to have doing so in order to produce the audible flag.

Epler in view of Fan further in view of Kuechler fails to teach that the call information comprises at least one selected from the group consisting of geographical location, and time zone information. Neil teaches that the call information comprises at least one selected from the group consisting of geographical location, and time zone information (col.13, lines 31-39). Thus, it

would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Epler in view of Fan further in view of Kuechler to have the call information comprising at least one selected from the group consisting of geographical location, and time zone information as taught by Neil. The motivation for the modification is to have doing so in order to take advantage of commercially available telephone caller identification device.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wise et al. (U.S. Patent No. 5,884,262) teach Computer network audio access and conversion system, Kung et al. (U.S. Patent No. 6,563,797) teach IP voice call surveillance through use of non-dedicated IP phone with signal alert provided to indicate content of incoming call prior to an answer as being a monitored call and Bridger (European Patent application No. EP 0986223 A2) teach Internet message waiting signal.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S Elahee whose telephone number is (703)305-4822. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703)305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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